

REMARKS

Claims 1-19, 21-28, 30-34 and 36-46 are pending in this application.

Claims 1-19, 21-22, 33-34 and 36-46 are rejected under 35 U.S.C. §101.

Claims 1-4, 7-8, 12-13, 16, 23-24, 31-34, 37-38 and 46 are rejected under 35 U.S.C. §102.

Claims 2-11, 18 and 36 are rejected under 35 U.S.C. § 112.

Claim 32 is objected to because of an informality.

Claim 33 is amended for readability in order to clarify an antecedent basis for the printing of information obtained from a data stream.

Applicant hereby traverses the outstanding objections and rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein.

Rejections under 35 U.S.C. § 101

Claims 1-19, 21-22, 33-34 and 36-46 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Regarding claims 1-19 and 21-22, the Office Action states that the “driver” in base claim 1 is typically considered software and that software per se is not patentable. The rejection of claims 2-19 and 21-22 stems from their dependence from rejected claim 1. However, the M.P.E.P. states that

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed solely to an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.

M.P.E.P. § 2106.A. Applicant asserts that the Examiner has not provided a *prima facie* showing that the invention of claims 1-19 and 21-22 are not statutory under 35 U.S.C. § 101.

Further, Applicant asserts that the claimed invention qualifies as a Computer-Related Processes Limited to a Practical Application in the Technological Arts. M.P.E.P. § 2106.IV.B.2.(b).i-ii. A claim is statutory subject matter if it “is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result.” M.P.E.P. § 2106.IV.B.2.(b).ii. The M.P.E.P. provides four examples, at least three of which being directly analogous to the present claims. These are 1) “optimally controlling transfer ... of data ... such that the most frequently used data is readily available,” 2) “controlling parallel processors to accomplish multitasking ... to maximize computing efficiency” and 3) “removing noise from a digital signal comprising the steps of calculating a mathematical algorithm ... to remove the noise.” These examples compare directly with “abstracting at least a portion of said data bits ... for controlling ... printing of a postage indicia” in terms of producing a concrete, tangible and useful result.

Therefore, Applicant respectfully asserts that the claimed invention is a Computer-Related Processes Limited to a Practical Application in the Technological Arts and that claims 1-19 and 21-22 are directed to statutory subject matter. Accordingly, Applicant respectfully asserts that claims 1-19 and 21-22 are patentable over the 35 U.S.C. § 101 rejection of record and requests that the Examiner withdraw the rejection.

For claims 33-34 and 36-46, the Office Action points out that base claim 33 does not expressly cite a computer readable medium. The rejection of claims 34 and 36-46 stems from their dependence from rejected base claim 33.

Although not agreeing that express recital of a computer readable medium is required to render the invention statutory subject matter, Applicant has amended claim 33 to recite that the computer program product is embodied on a computer-readable medium in an effort to expedite prosecution. Accordingly, Applicant respectfully requests that the Examiner withdraw 35 U.S.C. § 101 rejection for claims 33-34 and 36-46.

Rejections under 35 U.S.C. § 102

Claims 1-4, 7-8, 12-13, 16, 23-24, 31-34, 37-38 and 46 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,401,943 to Dietrich et al. (hereinafter Dietrich).

In order to anticipate a claim, however, the reference must teach every element of the claim. M.P.E.P. § 2131. Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Applicant traverses the rejections and asserts that the 35 U.S.C. § 102 rejection of record does not satisfy these requirements and that the claims are allowable for, at least, the reasons stated below.

Base claims 1, 23 and 33

Claim 1 recites, in part, “[a] printer driver for association with a data stream being presented to a printer ... said data stream containing data bits useful for controlling functions additional to said printing ..., said driver comprising: means for abstracting at least a portion of said data bits from said data stream.” Applicant asserts that Dietrich does not disclose at least this aspect of claim 1.

Dietrich does not disclose a printer driver as set forth in the claim. Instead, Dietrich discloses a hardware “read-write module,” which is labeled a “READ/WRITE DEVICE” in the figure. Dietrich, column 1, lines 45-46 and column 2, lines 65-68. Applicant notes that it is Dietrich’s read-write module – not a printer driver – which reads information and transmits it to postage and address printing functions. Dietrich, column 3, lines 1-5 and 46-50. The read-write device of Dietrich does not meet the recited printer driver.

Further, claim 1 recites, in part, “means for using at least some of said abstracted data for controlling at least one of said additional functions ...” and “means for creating, from said abstracted data, data for controlling the printing of said postage indicia.” This “abstracted data” is abstracted from a data stream that is being presented to a printer. Applicant asserts that Dietrich does not disclose at least this element of claim 1, either. For example, Dietrich does not read a data stream that is being presented to a printer. Instead Dietrich’s “read-write module” reads information from a computer-readable data storage medium whose substantive contents are not to be printed, and therefore are not being presented to a printer. Dietrich, column 1, lines 51-56; and column 2, lines 64-65. See also column 1, lines 14-19.

Accordingly, Applicant respectfully asserts that Dietrich does not meet the claim as required under 35 U.S.C. § 102.

Claim 1 also recites, in part, “[a] printer driver for association with a data stream being presented to a printer ... said driver comprising: means for abstracting at least a portion of said data bits from said data stream; means for using at least some of said abstracting data for controlling at least one of said additional functions ... and means for creating ... data for controlling the printing ...” Applicant asserts that Dietrich does not disclose this level of detail. No details or suggestions are provided in Dietrich concerning any “abstraction” or other activity that may be occurring to data that is presented to any printing device. Dietrich neither discloses nor suggests the existence of any abstracting function or any other special relationship between the read-write module and any printer or printer driver – other than inferring simple connectivity. Thus, Applicant respectfully asserts that the identical invention is not shown in Dietrich in as complete detail as is contained in Applicant’s claim 1. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1 and assert that claim 1 is allowable for, at least, the reasons stated above.

Claim 23 recites, in part, “sending a data stream to a printing device [and] reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents.” Applicant asserts that Dietrich does not disclose at least this element of claim 23.

Dietrich does not disclose reviewing a data stream that is being sent to a printing device and creating therefrom a separate data stream for controlling additional functions with respect to printing. Instead, Dietrich discloses using a hardware “read-write module,” which directly transmits to either a bookkeeping means or a “special address printer” separately. Dietrich, column 3, lines 1-5 and 42-43. No details or suggestions are provided in Dietrich concerning “reviewing” either the data sent to the bookkeeping means or the special address printer in order to create a separate data stream.

Applicant respectfully asserts that Dietrich does not disclose sending a data stream to a printing device and reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents. Accordingly,

Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 23 and assert that claim 23 is allowable for, at least, the reasons stated above.

Claim 33 recites, in part, “an abstracting program operable for reviewing said data stream to obtain therefrom information for controlling printing operations ancillary to said printing operation.” The “data stream” is defined in the preamble as “a data stream being directed to a general purpose printer, said data stream adapted to enable said printer to print information in accordance with said data stream.” Applicant asserts that Dietrich does not disclose at least this aspect of claim 33. Instead, Dietrich discloses reading information from a data storage medium that is to be mailed – not a data stream being directed to a general purpose printer. Dietrich, column 1, lines 13-18, and column 3, lines 43-45. Further, Dietrich discloses only “a postage meter device” and “a special address printer,” not a “general purpose printer.” Dietrich, column 3, lines 29-30 and 43.

Applicant respectfully asserts that Dietrich does not disclose an abstracting program operable for reviewing a data stream being directed to a general purpose printer to obtain therefrom information for controlling ancillary printing operations. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 33 and assert that claim 33 is allowable for, at least, the reasons stated above.

Dependent claims

Claims 2-4, 7-8, 12-13, and 16 depend from base claim 1, claims 24 and 31-32 depend from base claim 23, and claims 34, 37-38 and 46 depend from base claim 33. The dependent claims each inherit all the limitations of their respective base claims. As shown above, Dietrich does not anticipate base claims 1, 23 or 33. Applicant asserts that these claims are patentable for, at least, the reasons set forth above with respect to the base claims 1, 23 and 33. Accordingly, Applicant requests the Examiner withdraw the U.S.C. § 102(e) rejection of claims 2-4, 7-8, 12-13, 16, 24, 31-32, 34, 37-38 and 46. Moreover, these dependent claims set forth additional features and limitations not disclosed by Dietrich.

For example, claim 4 recites, in part, “said at least one additional function further comprises a dialog box for allowing options from a user.” The Office Action states that “any

personal computer inherently must have the user input interface.” Applicant traverses this rejection for at least two reasons.

Simply having a dialog box in an application is insufficient to meet the express limitations of the claim. Claim 4 requires abstracted data to be used in controlling a dialog box for allowing options from a user. Nothing in the statement of record regarding applications generally having dialog boxes is sufficient to anticipate the limitations of claim 4.

Moreover, the rejection of record is insufficient to establish inherency with respect to a dialog box. The M.P.E.P. states, “[t]he fact that a certain characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Instead, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112. Dietrich discloses an automated printing system – without mentioning any need for user input. Therefore, a dialog box for allowing options from a user does not necessarily flow from the teachings of Dietrich.

Claim 5 recites, in part, “accepting data from a source other than said data stream.” Dietrich discloses only accepting data from a single source – the “INFORMATION CARRIER” shown in the figure.

Claim 8 recites, in part, “at least one additional function further comprises directing the abstracted portion to a viewable medium.” Dietrich does not disclose or suggest directing any information read from the “INFORMATION CARRIER” to a viewable medium – only an “ADDRESS PRINTING DEVICE” and a “POSTAGE METER DEVICE.”

Claim 9 recites, in part, “at least one additional function further comprises the changing of form of the data.” Dietrich does not disclose changing the form of any information that is read before it is printed.

Claim 11 recites, in part, “at least one additional function further comprises the change in location and/or format of the data based upon an interaction between certain data in

said data stream and data stored in said printer driver.” Dietrich does not disclose changing the format of any information that is read before it is printed. Nor does Dietrich disclose any interaction between any data stream and a printer driver that could affect the location or format of any data.

Claim 12 recites, in part, “said printer driver is operable on said data stream coming from a program operating in a computing device to control at least a portion of the printing of said printer.” Dietrich discloses printing only information coming from a hardware “INFORMATION CARRIER,” not from a “program.”

Claim 15 recites, in part, “means for examining said data stream for preestablished data patterns.” Dietrich does not disclose examining data for preestablished data patterns, but rather, reading from reserved memory locations labeled 1 and 2 in the figure. Also see Dietrich, column 2, lines 62-65.

Claim 37 recites, in part, “said computer product is operable on said data stream coming from a general purpose computing device.” Dietrich does not disclose operating on a data stream coming from a general purpose computing device, but rather the output of an “INFORMATION CARRIER,” such as a chip card, and a “READ WRITE DEVICE” that is separate device from a general purpose computing device. See Dietrich, column 3, lines 45-49 disclosing that a personal computer requires a “read-write module” to be attached in order to read from the “information carrier.”

Claim 40 recites, in part, “said abstracting program includes: a control program for examining said data stream for certain preestablished data patterns.” Dietrich does not disclose examining data for preestablished data patterns, but rather, reading from reserved memory locations labeled 1 and 2 in the figure. Also see Dietrich, column 2, lines 62-65.

Rejections under 35 U.S.C. § 112

Claims 2-11, 18, 23-28, 30-32, 36 and 46 are rejected under 35 U.S.C. § 112, second paragraph.

Rejections for indefiniteness

Claims 2-11, 18 and 36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action states that the term “comprises” in claims 2-11, 18 and 36 should be “further comprises.”

Applicant respectfully asserts that the term “comprises” in claims 1 and 33 is an open-ended transitional phrase and allows for additional limitations to be included. Therefore, recitation of “comprises” to introduce additional limitations in dependent claims 2-11, 18 and 36 is proper. Nevertheless, in the interest of expediting issuance, the Examiner’s suggestion of including the word “further” is adopted for claims 2-11, 18 and 36. The foregoing amendment does not alter the scope of the claims.

Claim 3 is further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite as not having proper antecedent basis for “said printing.” Claim 3 is amended to clarify which printing is referenced. The foregoing amendment does not alter the scope of the claim.

Claim 46 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the phrase “data patterns” is asserted to lack antecedent basis. Claim 46 is amended to correct the typographical error that caused the ambiguity. Claim 46 properly depends from claim 40, which provides the antecedent basis for “data patterns.” No new matter has been added by this correction.

In light of the amendments and remarks above, Applicant respectfully requests that the Examiner withdraw 35 U.S.C. § 112 rejection for claims 2-11, 18, 36 and 46.

Rejections for omitting essential steps

Claims 23-28, and 30-32 are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. Specifically, the Office Action indicates that a step stating “printing certain information on a printed document” is omitted from base claim 23. Claims 24-24 and 30-32 depend from claim 23, and their rejections stem from the rejection of claim 23.

Applicant respectfully points out that printing is expressly recited in the first clause of the claim as previously submitted. However, the Examiner’s suggestion of highlighting the

printing as a discrete step has been adopted. Because the printing step had been recited in the first clause of the claim body, the change dictates minor editing of the claim. The original reference to printing has been removed to avoid duplication. Also, the word "said" has been deleted in the second clause to avoid potential ambiguity arising for the antecedent bases of "printing" and "document." And finally, the word "certain" has been deleted from the preamble to avoid ambiguity with the wording of the new discrete clause.

Paragraph 6 in the 35 U.S.C. § 112 rejection section of the Office Action appears to suggest that claim 46 is also rejected along with claims 24-28 and 30-32. This rejection implies a dependence from claim 23. The Examiner may have misread the dependence. As originally presented, claim 46 incorrectly appeared to depend from base claim 33. As amended, it properly reflects dependence from base claim 33 through claim 40. In neither case, though, should the 35 U.S.C. § 112 rejection of claim 23 affect the patentability of claim 46.

In light of the amendments and remarks above, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112 rejections of claims 23-28, 30-32 and 46.

Objections

Claim 32 is objected to because of an informality. Claim 32 has been amended both as suggested by the Examiner and also for consistency in the punctuation. The foregoing amendment does not alter the scope of the claim.

Applicant respectfully requests that the Examiner withdraw the objection to claim 32.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

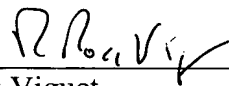
Application No.: 09/469,561

Docket No.: 61135/P016US/10106022

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P016US/10106022 from which the undersigned is authorized to draw.

Dated: April 11, 2005

Respectfully submitted,

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